

- D) preparing 2-methyl-4-(4-methyl-1-piperazinyl)-10H-thieno[2,3-b][1,5]benzodiazepine by refluxing the reaction product of step (C) with a mixture of N-methylpiperazine, dimethylsulphoxide and toluene.

26. (new) A method of preparing 2-methyl-4-(4-methyl-1-piperazinyl)-10H-thieno[2,3-b][1,5]-benzodiazepine comprising the following steps:

- A) preparing 2-amino-5-methylthiophene-3-carbonitrile by mixing sulfur, propionaldehyde in dimethylformamide, then adding triethyl amine, then adding malononitrile;
- B) preparing 2-(2-nitroanilino)-5-methylthiophene-3-carbonitrile from the reaction product of step (A) by reaction with aqueous sodium hydroxide in dimethylsulphoxide and 2-fluoronitrobenzene;
- C) preparing 4-amino-2-methyl-10H-thieno[2,3-b][1,5]benzodiazepine hydrochloride from the reaction product of step (B) by reacting with a slurry of 2-(2-nitroanilino)-5-methyl-thiophene-3-carbonitrile in ethanol and a solution of anhydrous stannous chloride in hydrochloric acid;
- D) preparing 2-methyl-4-(4-methyl-1-piperazinyl)-10H-thieno[2,3-b][1,5]benzodiazepine by refluxing the reaction product of step (C) with a mixture of N-methylpiperazine, dimethylsulphoxide and toluene.

REMARKS

A Supplemental Information Disclosure Statement is submitted herewith wherein Applicants wish to bring to the attention of the Office that the validity of a grandparent patent (U.S. Patent No. 5,229,382) of the present reissue patent application is being challenged in the United States District Court for the Southern District of Indiana, Indianapolis Division, Civil Action No.IP01-443 C Y/S. The corresponding post trial briefs of the parties are being supplied to the Office in this Supplemental IDS. In addition, Applicants wish to inform the Office that copies of the corresponding trial transcripts, expert opinions, and trial exhibits can be provided directly to the Office if so desired.

The Office submitted that the amendment filed by Applicants on December 18, 2001 which proposed to amend claim 1 did not comply with 37 CFR § 1.173(b) which sets forth the manner of making amendments in reissue application and that a supplemental paper correctly amending the reissue application is required. Applicants respectfully submit that

Serial No. 10/023,132

claim 1 has further been amended to correct the misspelling in the original patent claim 1, step C, of the word “thiono” which now correctly reads “thieno”. It is respectfully submitted that this amendment introduces no new matter to the specification. In particular, please refer to column 14, lines 46 and 47 of US 6,008,216.

The Office rejected claims 25 and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants submit that claims 25 and 26 have been amended herewith to correct the typographical error wherein the word “2-fluoronitrobenze” as shown in step B of the claims was misspelled and is now correctly spelled as “2-fluoronitrobenzene”. It is respectfully submitted that one of ordinary skill in the art would readily appreciate that the word “2-fluoronitrobenze” referred to “2-fluoronitrobenzene” when read in light of the specification as a whole. In view of these amendments, it is respectfully asserted that claims 25 and 26 comply with 35 U.S.C. § 112, second paragraph and the rejection thereof is obviated. It is further respectfully submitted that these amendments introduce no new matter to the specification.

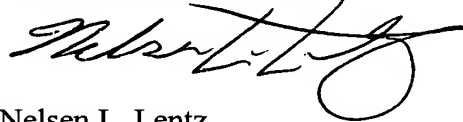
The Office rejected claims 2-13 under 35 U.S.C. § 103(a) as being unpatentable over Chakrabarti et al., U.S. 4,172,831. Applicants submit that claims 2-13 have been canceled by amendment without prejudice to the Applicants to prosecute said canceled claims in a later filed divisional application, and therefore, Applicants do not acquiesce to said rejection. Hence, Applicants respectfully submit that the rejections of claims 2-13 under 35 U.S.C. § 103(a) are now moot.

The Office indicated that the reissue oath/declaration filed with the application is defective because applicants indicate that there are 34 claims, however, as the Office noted, there were only 26. Applicants respectfully submit that although the number of claims and their number designations in the reissue oath/declaration were not identical to those in the preliminary amendment of December 18, 2001, a proper statement of error was provided in the initial reissue oath/declaration establishing the grounds for reissue. Thus, submission of a supplemental oath/declaration can be deferred until the application is otherwise in condition for allowance (MPEP 1444, page 1400-54, column 1, Rev. 2, May 2004) Hence, Applicants respectfully request that submission of a Supplemental Reissue Oath/Declaration pursuant to 37 CFR 1.175, be deferred until the present Reissue Patent Application is otherwise in condition for allowance.

Serial No. 10/023,132

In view of the above amendment and remarks, Applicants submit that claims 1, 25, and 26 are in condition for allowance. Reconsideration and withdrawal of the rejections is respectfully requested and allowance of claims 1, 25, and 26 is kindly solicited.

Respectfully submitted,



Nelsen L. Lentz
Attorney for Applicants
Registration No. 38,537
Telephone No. (317) 276-1207

Patent Division
Eli Lilly and Company
P. O. Box 6288
Indianapolis, Indiana 46206-6288

October 18, 2004